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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/467,442 12/20/99 FARER

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EXAMINER

HM22/0313

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ART UNIT PAPER NUMBER

1615  
DATE MAILED:

03/13/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/467,442

Applicant(s)

FARER ET AL.

Examiner

Liliana Di Nola-Baron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

The examiner acknowledges receipt of Applicants amendment, filed on January 29, 2001.

#### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Horino et

al. The claimed invention refers to a cosmetic composition comprising particulates at least partially coated with fluorosilane, and to a method of:

- a. reducing staining potential of a lipstick, comprising applying to a person a lipstick having the claimed cosmetic composition.
- b. improving water and/or oil resistance in a mascara, comprising applying to a person a mascara having the claimed cosmetic composition.
- c. improving wear resistance of a cosmetic having a plurality of particulates, comprising coating some of the particulates with fluorosilane.
- d. reducing oil breakthrough in a facial product, comprising applying to a person a facial product having the claimed cosmetic composition.
- e. reducing color drift in a powder cosmetic, comprising applying to a person a powder cosmetic having the claimed cosmetic composition.
- f. moisturizing skin, comprising applying to the skin the claimed cosmetic composition.

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Horino et al. provides water and oil repellant coated powders intended for make-up cosmetics and a method for producing the coated powders (See e.g., col. 2, line 64 to col. 3, line 4). Horino et al. discloses a water and oil repellant coated powder having a coating layer of the water and oil repellant agent chemically bonded to an active site on the surface of an inorganic base powder, and a method for producing water and oil repellant coated powders, comprising contact-reacting an inorganic base powder with a gaseous water and oil repellant agent on the surface of the base powder (See e.g., col. 3, lines 5-17). Horino et al. teaches that the cosmetics of the invention remain free from the tendency to become transparent due to water, perspiration or sebum or from unevenness or makeup dry of the makeup finish for a prolonged time (See e.g., col. 3, lines 22-26). Horino et al. teaches that inorganic pigments, inorganic powders or mixtures thereof may be employed as inorganic base powders, and that the water and oil repellant agent is exemplified by fluorosilane, fluorsilazane or fluorinated hydrocarbons (See e.g., col. 5, lines 16-31). Horino et al. teaches that the weight ratio of the inorganic base powder to the water and oil repellant agent is 1:0.005 to 1:0.50 (See e.g., col. 5, lines 50-59) and that the amount of the coated powders in the makeup cosmetics may be 1 to 40% for emulsion type, 0.5 to 30% for oil gel type and 5 to 90% for pressed or loose type (See e.g., col. 8, lines 36-42). Among the inorganic pigments of the invention, Horino et al. includes white pigments, such as titanium oxide or zinc oxide, red pigments, such as iron oxides or iron titanate and yellow pigments, such as yellow iron oxide or yellow ochre. Among the inorganic powders of the invention, Horino et al. includes talc, calcium carbonate, synthetic mica and silicate (See e.g., col. 9, lines 7-43). In Example 1-3, Horino et al. teaches that the foundation composition comprises demineralized water, which is a vehicle, and stearic acid and octyldodecyl oleinate, which are penetration enhancers.

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The compositions and methods disclosed by Horino et al. meet the limitations of claims 1-20 of the instant application, as they contemplate cosmetic compositions comprising particulates at least partially coated with fluorosilane and the application of said cosmetic compositions to the skin to prevent makeup unevenness or makeup dry and provide an even applied cosmetic thin layer. Thus, Horino et al. anticipates the claimed invention.

3. Claims 1-8, 12, 16, 20 and 21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Itou et al. The claimed invention refers to a cosmetic composition comprising particulates at least partially coated with fluorosilane, and to a method of:

- a. improving wear resistance of a cosmetic having a plurality of particulates, comprising coating some of the particulates with fluorosilane.
- b. moisturizing skin, comprising applying to the skin the claimed cosmetic composition.

Itou et al. discloses a water-based manicure obtained by coating and treating the surface of the inorganic powder with a water and oil repellent and blending the resultant pigment therein, with the purpose of producing a water-based manicure with improved water resistance. Itou et al. teaches that a fluorosilane can be used as water and oil repellent and talc, sericite, mica or titanium-treated mica may be used as inorganic pigment. Additionally, Itou et al. teaches that the water-based manicure is preferably blended with 0.1-10% by weight, especially 0.2-4% by weight, of the inorganic pigment (See e.g., Abstract).

The compositions and methods disclosed by Itou et al. meet the limitations of claims 1-8, 12, 16 and 20 of the instant application, as they contemplate cosmetic compositions comprising

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particulates at least partially coated with fluorosilane and the application of said cosmetic compositions to the skin. Thus, Itou et al. anticipates the claimed invention.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horino et al. in view of Bugnon et al. The claimed invention refers to a cosmetic composition comprising particulates at least partially coated with fluorosilane, wherein said particulates are selected from the group consisting of organic or inorganic pigments, fillers and mixtures thereof. The teachings of Horino et al. have been summarized above (See 35 U.S.C. 102 rejection). Horino et al. does not include organic pigments in the coated powder of the invention. Bugnon et al. discloses compositions comprising an organic material in the form of paint system or printing ink and a pigment composition in which an organic pigment is coated with an alkyl silicate (See e.g., col. 2, line 15 to col. 3, line 55). Bugnon et al. teaches that all customary organic pigments are suitable for the preparation of the compositions of the invention (See e.g., col. 3, lines 58-65). Additionally, Bugnon et al. teaches that the pigment compositions of the invention are especially suitable for coloring aqueous and/or solvent-borne paint systems (See e.g., col. 5, lines 18-21).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cosmetic coated powders disclosed by Horino et al., by inserting an organic pigment, as taught by Bugnon et al. One of ordinary skill in the art would have been motivated to make such a modification to prepare lipstick formulations with reduced staining potential. Because of the teachings of Bugnon et al., that organic pigments may be coated with silane, one of ordinary skill in the art would have a reasonable expectation that a cosmetic preparation comprising an organic pigment coated with fluorosilane would be successful. Therefore the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

### ***Response to Arguments***

6. Applicant's arguments filed on January 29, 2001 have been fully considered but they are only partially persuasive.

7. In response to Applicants argument, that Horino et al. does not provide any cosmetic composition containing any of the ingredients recited in amended claim 1, it is noted that the foundation composition disclosed in Example 1-3 in the prior art includes stearic acid and octyldodecyl oleinate, which are penetration enhancers, and coated pigment, routinely used as sunscreen. With respect to claim 19, Horino et al. teaches that inorganic powders used in the invention include non-pigmented powders, such as calcium carbonate (See e.g., col. 9, lines 26-42).

8. Applicants amendment has overcome the rejections over Nishihara et al. and Horino and Itou. Accordingly, those rejections are moot.

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9. In response to Applicants argument, that Horino and Itou does not disclose cosmetic compositions containing fluorosilane coated particles, a vehicle and an ingredient recited in amended claim 1, it is noted that the prior art discloses a water-based manicure (water is a vehicle), in which an inorganic pigment (sunscreen) is coated with fluorosilane.

10. In response to applicant's argument that Bugnon et al. is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the organic pigments disclosed by Bugnon et al. are routinely used in cosmetics. For example, diketopyrrolopyrrole, which is the preferred organic pigment in Bugnon et al., is disclosed as a red pigment in cosmetic compositions by Lemann et al. (See enclosed reference).

### ***Conclusion***

Claims 1-21 are rejected.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period



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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liliana Di Nola-Baron whose telephone number is 703-308-8318. The examiner can normally be reached on Monday through Thursday, 5:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1234/ 1235.

March 7, 2001

THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600